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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,739	03/18/2004	Bao Tran	AFL-016	8291
31688	7590	04/14/2010		
TRAN & ASSOCIATES P.O. Box 68 Saratoga, CA 95071-0068			EXAMINER SKINNER, SHEWANA D	
			ART UNIT 3689	PAPER NUMBER
			MAIL DATE 04/14/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/804,739

**Applicant(s)**

TRAN, BAO

**Examiner**

SHEWANA SKINNER

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

### DETAILED ACTION

This communication is a Final Action in response to correspondence received in 12/22/2009. Claims 1 and 19-23 have been amended. **Claims 1-24** have been considered below.

#### *Response to Amendment*

1. The 35 U.S.C. §112 2nd rejection of Claims 1-24 in reference to the means required to perform steps of the method has been withdrawn. Applicant has included a program executed on a local computer to perform the steps.
2. The 35 U.S.C. §112 2nd rejection of Claims 19 and 20 has been withdrawn in light of Applicant's removal of the indefinite language, "freedom to operate" via an amendment of the claims. However new 112 1<sup>st</sup> and 2<sup>nd</sup> rejections have been made.
3. The 35 U.S.C. §101 rejection of Claims 1-24 has been withdrawn in light of Applicant amending claim to include the executing of a program on a local computer to perform the steps of the method creating a statutory process.
4. The 35 U.S.C. §102 rejection of Claims 1-12, 14-17 and 23-24 have been rendered moot in light of Applicant's amendment's. However new grounds of rejections have been made under 103(a) *PAIR: Patent Application and Information Retrieval, Press Release (1999)* in view of *Grainger (US 2002/0161733)*.
5. The 35 U.S.C. §102 rejections of Claims 19-20 and 22 have been rendered moot in light of Applicant's amendment's. However new grounds of rejections have been made under 102(b) *Rivette (US 2003/0046307)*.

6. The amendment filed 12/22/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: **Claim 1** recites the limitation of, "for each file the program determining an application identifier for the file. Said language is not support in the original specification. As per Applicant's disclosure, Fig 1C states the step of "determining application identifier for the docket item" however said step and subsequent steps are interpreted as being performed by the user not the program.

Applicant is required to cancel the new matter in the reply to this Office Action.

7. The amendment filed 12/22/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: **Claims 19 and 20** recite the limitations: determining IPs infringed by the owner of a predetermined IP and number of IPs infringed by the owner of a predetermined IP as a defense. Said language is not support in the original specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

#### ***Response to Arguments***

1. Applicant's arguments filed 12/22/2009 with respect to Claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

2. Applicant's arguments filed 12/22/2009 with respect to Claims 23 have been found non-persuasive. Applicant argues that *PAIR* uses the aa and bbbbbb of the patent application number in order to locate a document where applicant is claiming to use only the bbbbbb. Examiner finds the statement unpersuasive as an argument to overcome the prior art in that Applicant's Claim 23 uses the bbbbbb code and Claim 24 uses the aa code, therefore it is simply a matter of sequence where the outcome is the same.
3. In addition, Applicant argues that, in reference to Claim 1, *Grainger*1 does not disclose "and displaying the deadline based on a downloaded file wrapper document" however said limitation is not recited in the claim language.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claim 1** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

**Claim 1** recites the limitation of: "for each file the program determining an application identifier for the file. Said language is not support in the original specification. As per Applicant's disclosure, Fig 1C states the step of "determining application identifier for the docket item"

however said step and subsequent steps are interpreted as being performed by the user not the program.

**Claims 19 and 20** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **Claims 19 and 20** recite the limitations of: “determining IPs infringed by the owner of a predetermined IP” and “number of IPs infringed by the owner of a predetermined IP as a defense”. Said language is not support in the original specification.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **Claim 1** recites the limitation of; "for each file the program determining an application identifier for the file. Said language is not support in the original specification. As per Applicant's disclosure, Fig 1C states the step of “determining application identifier for the docket item” however said step and subsequent steps are interpreted as being performed by the user not the program. Examiner is unclear as to how said steps are performed and subsequently, unclear as to how a person would be able to ascertain the metes and bounds of the Applicant's invention. Therefore, the invention is indefinite.

**Claims 19 and 20** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **Claims 19 and 20** recite the limitations of: “determining IPs infringed by the owner of a predetermined IP” and “number of IPs infringed by the owner of a predetermined IP as a defense”. This step is not disclosed within the specification and Examiner is unclear as to how the step is to be performed therefore the claims are indefinite.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 19-20 and 22** are rejected under 35 U.S.C. 102 (b) as being unpatentable *Rivette* (US 2003/0046307), hereinafter “*Rivette*”.

*Rivette* discloses the following as claimed:

**Claim 19.** (Currently Amended) A method for intellectual property (IP) management [?], comprising: executing a program on a local computer for [22]; searching one or more databases on a computer for one or more relevant IPs to an owner of a determined IP; performing a network analysis; and determining IPs infringed by the owner of the predetermined IP [11], [1096], [1104], [1320-1323], [1362] and [1384].

**Claim 20.** (Currently Amended) The method of claim 19, comprising acquiring the least number of IPs infringed by the owner of the predetermined IP as a defense [11] and [1096].

**Claim 22.** (Currently Amended) A computer implemented method to retrieve intellectual property documents, comprising:

executing a program on a local computer for [22];

receiving an assignee name in lieu of a patent number [401], published

application number or application serial number; and

for each file belonging to the assignee name,

downloading PDF copies of all patents and patent applications

matching the assignee name to a computer [420], [312] and [806].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-12 and 14-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over *PAIR: Patent Application and Information Retrieval, Press Release (1999)*, hereinafter, "*PAIR*" in view of *Grainger (US 2002/0161733)*, hereinafter, "*GraingerI*".

**As per Claim 1**, *PAIR* discloses a computer implemented method for providing an electronic file wrapper information for intellectual property applications (press release), comprising: executing a program on a local computer for authenticating a user with a patent office computer (press release); determining an application identifier for the file (Accessing Issued Patents and Accessing List of Applications); searching the patent office computer and



determining docket information (press release); and downloading one or more file wrapper documents associated with the docket information from the patent office computer to the local database (Fig 1). In addition, Applicant's disclosure details the knowledge selecting and downloading of utilizing the *PAIR* system to retrieve file wrapper images in TIFF format (Applicant's disclosure pgs 2-3).

However, *PAIR* does not explicitly disclose automatically adding a docket entry with a deadline for each new docket item as referenced in Claim 1.

*Grainger1* discloses a computer-implemented method of facilitating the preparation of intellectual property documents [24] and [33] with an electronic workflow pipeline [26] and [30] where the user is authenticated with a patent office computer [1], [50] and [136], each file has an application identifier [57] tracking the status of pending patent applications by authorized interface with the patent office [46], electronic filing, retrieving and prosecution of application with patents offices [30],[34] [26] and [139]; and automatically adding a docket entry with a deadline for each new docket item [31], [124].

It would have been obvious to one of ordinary skill in that art at the time the invention was made to add a docket entry with a deadline as disclosed in *Grainger I* to the document information received from *PAIR* as it is well-known practice on patent management to add deadlines for docketed information in order to effectively and efficiently prosecute the patent application.

**Claim 2** (Original) *PAIR* in view of *Grainger I*, discloses the method of claim 1, wherein said document is a portable document format (PDF) document (*Grainger I* [64] and [117] where said documents are retrieved and then converted into PDF).

**Claim 3** (Original) *PAIR* in view of *Grainger I*, discloses the method of claim 1, comprising generating a text-searchable PDF document containing all images for the entry. (*Grainger I* [47]).

**Claim 4** (Original) *PAIR* in view of *Grainger I*, discloses the method of claim 1, wherein the electronic file wrapper information includes a plurality of entries each having a mail-room date and a document description, comprising generating a single electronic document for each entry in the electronic file wrapper information. (*Grainger I* [85] where the mail-room date is the date the documents are mailed from patent offices), [57] and [58] where the file wrapper is the Case Data Unit and [59] where a single document is a Document Entity, [115] and [118])

**Claim 5** (Currently Amended) *PAIR* in view of *Grainger I*, discloses the method of claim 1, comprising automatically determining a deadline from a mail-room date in the electronic file wrapper information (*Grainger I* [85] and [86]).

**Claim 6** (Currently Amended) *PAIR* in view of *Grainger I*, discloses the method of claim 1, comprising automatically docketing a deadline from a mail-room date in the electronic file wrapper information (*Grainger I* [84-86]).

**Claim 7** (Original) *PAIR* in view of *Grainger I*, discloses the method of claim 1, wherein the electronic file includes a folder containing at least one file for each entry, comprising periodically updating folder content with one or more new entries from the patent office electronic file wrapper information (*Grainger I* [58] and [117], [120] upload document).

**Claim 8** (Original) *PAIR* in view of *Grainger I*, discloses the method of claim 1, comprising generating a single electronic document for each new (non-functional descriptive material) entry in the electronic file wrapper information, the document having all images for the entry consolidated therein (*Grainger I* [59], [115] and [117]).

**Claim 9** (Original) *PAIR* in view of *Grainger I*, discloses the method of claim 1, wherein the electronic file wrapper information includes a plurality of entries each having a mail-room date and a document description, comprising providing docketing information based on the mail-room date (*Grainger I* [84-85] and Fig 13).

**Claim 10** (Original) *PAIR* in view of *Grainger I*, discloses the method of claim 9, comprising generating a docket entry for one or more of the following: Information Disclosure Statement filing, foreign filing, Office Action response, response to missing part, notice of appeal, appeal brief, reply to response to appeal brief, notice of allowance, and annuity payment. (*Grainger I* [85] and [86] where a response to office action is docketed and [124] where a patent application with IDS is docketed)

**Claim 11** (Previously Presented ) *PAIR* in view of *Grainger I*, discloses the method of claim 9, comprising generating an email reminder for the docket entry (*Grainger I* [58] and [84] where the message is an email message).

**Claim 12** (Original) *PAIR* in view of *Grainger I*, discloses the method of claim 9, comprising generating a docketing message to a recipient (*Grainger I* [84]).

**Claim 14** (Previously Presented) *PAIR* in view of *Grainger I*, discloses the method of claim 1, comprising filing one or more electronic documents with the patent office computer and automatically adding corresponding docket entries for the one or more electronic documents (*Grainger I* [6], [92], [75],[123] and [124]).

**Claim 15** (Previously Presented) *PAIR* in view of *Grainger I*, discloses the method of claim 14, wherein the electronic documents include one or more of the following: utility patent applications, Provisional applications, Biosequence listings, Pre-grant publication resubmissions~ bio-sequence submissions, assignments, Electronic Information Disclosure Statements (eIDS), Design applications, New plant applications, Corrected or revised patent application republications, Reissue applications, International Patent Cooperation Treaty (PCT) applications, and Reexamination requests (*Grainger I* [92] IDS and Provisional).

**Claims 16 and 17** (Original) *PAIR* in view of *GraingerI*, discloses the method of claim 1, comprising displaying the electronic document in a tri-fold format (*GraingerI* [116] and [117]).

6. **Claim 13** rejected under 35 U.S.C. 103(a) as being unpatentable over *PAIR* in view of *GraingerI* further in view of *Simpson et al (US 6,549,894)*, hereinafter *Simpson*.

**As per Claim 13** (Original) *GraingerI* discloses the method of claim 12, comprising coding the docketing message of the docketing message ([84] where the rules can include coding).

However, it does not explicitly state the step of coding to indicate urgency.

*Simpson* discloses a computerized docketing system for intellectual property law with automatic due date alert where the actions a docketed in a color code that indicates the degree of urgency of the docket item (col 6 lines 2-17)

Therefore, from the teaching of *GraingerI*, it would have been obvious to one of ordinary skill in that art at the time the invention was made to include color coding in the docketing method as disclosed in *Simpson* in order to effectively alert a user of the system of matters requiring attention.

7. **Claim 18** is rejected under 35 U.S.C. 103(a) as being unpatentable over *PAIR* in view of *GraingerI* in view of *Grainger et al (US 2002/0059076)*, hereinafter “*Grainger2*”.

**As per Claim 18**, *GraingerI* discloses the method of claim 1, comprising searching one or more remote databases for one or more relevant intellectual properties (IPs) [96] and [97] where references are found relevant to the IDS).

However, it does not disclose performing a network analysis on the relevant IPs.

*Grainger2* discloses at [194] an invention analysis and [196] testing data where an analysis is performed.

Therefore, from the teaching of *Grainger1*, it would have been obvious to one of ordinary skill in that art at the time the invention was made to expand the IP search to an analysis as disclosed in *Grainger2* in order to provide an effective and complete method for securing intellectual property.

8. **Claim 21** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Rivette* in view of *Grainger2*.

**As per Claim 21**, *Rivette* discloses the method of claim 19 where patent information stored in the local database is received from the patent office [321], [807] and [1312].

However, it does not explicitly state the generation a single electronic document for an entry in the electronic file wrapper information, the document having all images for the entry consolidated therein as referenced in Claim 21.

*Grainger2* discloses receiving electronic file wrapper information from a patent office computer ([2] and [74], receipt); and generating a single electronic document for an entry in the electronic file wrapper information, the document having all images for the entry consolidated therein ([99] and [105]).

It would have been obvious to one of ordinary skill in that art at the time the invention was made to generate a single document as disclosed in *Grainger2* for the documents retrieved

and indexed in the database of *Rivette* as that method provides are more user friendly and effective way of viewing the information.

9. **Claim 23-24** is rejected under 35 U.S.C. 103(a) as being unpatentable over *PAIR: Patent Application and Information Retrieval, Press Release (1999)*, hereinafter, "*PAIR*" in view of *Grainger1*.

**As per Claims 23-24**, *PAIR* discloses; receiving an application serial number conforming to a format aa/bbbbbb (*PAIR*, Use of System - Accessing Issued Patents); retrieving a published patent application matching the bbbbbb (*PAIR*: Objectives); and generating a single electronic document having all pages of the patent application consolidated therein (*Pair*: Objectives) wherein the retrieving locates a plurality of matching patent applications, further comprising selecting the patent application whose Series Code matches aa (*Pair*, "Objectives").

However, although is discloses downloading file wrapper history, it does not explicitly disclose downloading file wrapper history as one or more PDF documents.

*Grainger1* discloses receiving file wrapper information and then converting it into a PDF document [117].

It would have been obvious to one of ordinary skill in that art at the time the invention was made to convert the retrieved document in *PAIR* into a PDF document as disclosed in *Grainger I* as that method provides a more user friendly, effective and secure way of viewing, storing and disseminating the information.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEWANA SKINNER whose telephone number is (571)270-7141. The examiner can normally be reached on Monday-Friday 8:00am to 4:00pm.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mooneyham Janice can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SHEWANA SKINNER/  
Examiner, Art Unit 3689

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